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EXAMINER

LY, CHEYNE D

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,763

Applicant(s)

CAWSE, JAMES NORMAN

Examiner

Cheyne D Ly

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 19, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 4, 18-22 and 35-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-17, and 23-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-42 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Applicant's election with traversal of species of claim 8 – steps (A)-(D), in Paper No.5, filed March 19, 2003, is acknowledged.
2. The traversal is on the ground(s) that it would not be unduly burdensome to perform a search on claims 1 to 17 and 22 to 42 together. Applicant cited claims 22 and 18-22 to be related and should be examined with the elected species. Applicant's arguments have been found to be not persuasive because the specific claims (22, and 18-21) cited by Applicant are directed to a variety of distinct mathematical analysis representations. This lack of overlapping searches documents the undue search burden if they were search together.
3. Claim 1 and its dependent claims that are not specifically directed to non-elected species are examined on the merits; the analyzing step is limited to the elected specie, claim 8 – steps (A)-(D).
4. The requirement is still deemed proper and is therefore made FINAL.
5. Claims 1-3, 5-17, and 23-34 are examined on the merits with the analyzing step of claim 1 limited to the elected specie, claim 8 – steps (A)-(D).

CLAIM REJECTIONS - 35 U.S.C. § 112, SECOND PARAGRAPH

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 1-3, 5-17, and 23-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1631

8. Claims 1, line 6; 13-15, line 2; and 16, 17, and 28, line 1, these claims have the relative term of “better” or “best” which causes the claims to be vague and indefinite. The relative terms are unclear as to what criteria are being used to determine that a particular data set is better or best from the other data sets. Claims 2, 3, 5-12, 23-27, and 29-34 are rejected for being directly or indirectly dependent from claim 1. Clarification of the metes and bounds is required.

9. Specific to claim 1, line 7, the phrase “factor levels” is set forth as being selected from the analysis of the last 2 lines of claim 1. However, there is not a step for defining, measuring or effecting the factor levels prior to the step where the factor level are being selected. Therefore, there is lack of antecedent basis for the limitation of defining the factors for example before the factor levels are selected for analysis. How can one select something that is not provided previously? Claims 2, 3, 5-17, and 23-34 are rejected for being directly or indirectly dependent from claim 1.

10. Specific to claim 8, step (D), claim 11, (iii), claim 12, line 3, the term “outside” causes the claim to be vague and indefinite. In examining according to step (D) and identifying according to step (iii), the step is unclear as to what criteria are being used to determine that specific identified effects are outside the standard deviation (greater or less than). Clarification of the metes and bounds is required. Claims 8-17 are rejected for being dependent from claim 8.

11. Claim 9, line 2, recites the limitation “representing...the $n \times 1$ matrix y ”. The inclusion of the said limitation causes the claim to be vague and indefinite due to step (B) of claim 9 being unclear. Claim 8, step (B), from which claim 9 depend has the limitation of $n \times n$ matrix X , while claim 9 further limits the said matrix to the $n \times 1$ matrix y . Therefore, the limitation of the

Art Unit: 1631

matrix required by step (B) of claims 8 and 9 conflicts with each other. Clarification of the metes and bounds is required.

12. Specific to claim 10, (ii), the variables X' and X are vague and indefinite. The said variables in step (i), claim 10, represent two different matrices. However, in another interpretation, the said variables represent numerical values to which the post multiplying step is performed. Is the post multiplying step performed using the matrices X and X' or the numerical values representing by the variables X and X'? Clarification of the metes and bounds is required.

13. Specific to claim 10, (iii), the variable y is vague and indefinite. The variable y in claim 8, step (A) represents a specific matrix. However, the said variable represents a numerical value to which the post multiplying step is performed to form the results. Is the post-multiplying step performed using the matrix y or the numerical values representing by the variable y? Clarification of the metes and bounds is required.

LACK OF ENABLEMENT UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method for defining leads from a complex chemical space (page 11-18), does not reasonably provide enablement for defining leads for a commercial process. The

Art Unit: 1631

specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

15. Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized in Ex parte Forman, 230 USPQ 546 (BPAI 1986) and reiterated by the Court of Appeals in In re Wands, 8 USPQ2d 1400 at 1404 (CAFC 1988). The factors to be considered in determining whether undue experimentation is required include: (1) the quantity of experimentation necessary, (2) the amount or direction presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. The Board also stated that although the level of skill in molecular biology is high, the results of experiments in genetic engineering are unpredictable. While all of these factors are considered, a sufficient amount for a prima facie case is discussed below.

16. It is acknowledged that applicant provide sufficient disclosure for defining leads from a complex chemical space (page 11-18). Further, the instant “invention provides a particularly well-suited experimental methodology to investigate multiple and complex interactions of a catalyzed chemical reaction” (page 3, lines 13-20). However, the instant application does not provide guidance or working examples for translating an experimental methodology to a generic commercial process. It is well established that experimental methods require many iterations of trial and errors processes to refine an experimental process to a commercial process. Therefore, The instant specification does not provide sufficient guidance or working examples for one skilled in the art to predictably use the claimed invention for a commercial process.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 1-3, 5-11, 13-17, 23-28, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agrafiotis et al. (US 5,901,069 A) taken with Grate et al. (US 6,408,250 B1).

19. Agrafiotis et al. discloses a method of defining an experimental space such as a combinatorial chemical library where a combinatorial chemical library could be constructed from chemical building blocks designated as A, B, and C. Further, the compounds in the combinatorial chemical library are equal to two in length, then, the compounds would be generated are: AA, AB,... and CC (total of nine) (column 5, lines 5-18), as in instant claims 1-7. The chemical building blocks comprise of 100 commercially available agents (column 5, lines 37-40), as in instant claim 16. The system may perform tests and evaluations on one or more structure-activity models in parallel (column 6, lines 43-45), as in instant claim 23. The method of Agrafiotis et al. performs selective micro scale solid-state synthesis of a specific combinatorial library of directed diversity library (column 8, lines 43-45), as in instant claim 24. The lead generation/optimization system is implemented in an iterative process wherein instructions are sent to a robotic synthesis system and reagents are mixed compounds are synthesized. The said

Art Unit: 1631

compounds are assayed and ranked; the best-ranked compound is selected (§ Operation of the present invention, columns 13-21) as in instant claims 15, 17, 25-28, and 34.

20. However, Agrafiotis et al. does not disclose the method of defining experimental space wherein the analysis is done according the steps defined in claim 8 of this instant application.

21. Grate et al. discloses the use of matrix algebra for characterizing, classifying, and identifying unknowns in a sample (Column 14, equation 10). Grate et al. defines matrices P containing the coefficients that are related to a plurality of descriptors (column 6, lines 59-65), as in claim 8, step (A). Matrix R where R is equal $C \cdot 10^{(vp+1c)} M^{-1} N$ (column 7, lines 7 and 8), as in claim 8, step (B) and claim 9. P^T is the transpose of matrix P (column 7, lines 16-17 and equations 12-14), as in claim 8, step (C) and claim 10, steps (ii) and (iii). The concentrations are plotted versus the fraction noise (RMSEP) in the data (e.g. 0.1 indicates that the standard deviation of the noise was 10% of the sensor signal) (column 20, lines 35-40 and Figure 1), as in claim 8, step (D) and claim 11.

22. An artisan of ordinary skill in the art at the tie^m of the instant invention would have been motivated to partake the concept emphasized by Agrafiotis et al. for an iterative process for generating chemical entities with define physical properties and/or bioactive properties (Abstract etc.) and improve on it by utilizing the method of Grate et al. which comprises using the properties chemical entities to identify a chemical sample. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the method of Agrafiotis et al. for generating chemical entities and determining the properties directed to the chemical entities; and identify and characterize the said chemical entities

Art Unit: 1631

according to the method of Grate et al. which comprises an algebra matrix for identifying a sample.

23. Claims 1-3, 5-11, 13-17, and 23-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agrafiotis et al. (US 5,901,069 A) taken with Grate et al. (US 6,408,250 B1) in view of Chaudhari et al. (US 5,917,077 A).

24. Agrafiotis et al. discloses a method of defining an experimental space such as a combinatorial chemical library. Further, Grate et al. discloses the use of matrix algebra for characterizing, classifying, and identifying unknowns in a sample (Column 14, equation 10) as cited above.

25. However, Agrafiotis et al. taken with Grate et al. does not disclose the limitation of palladium, halide or co-catalysts, which are the embodiments of the above listed instant claim rejected hereunder.

26. Chaudhari et al. discloses a method for preparing chemical entities using catalyst such as the metals of Group IIIB such as palladium and halide (Abstract etc.). Further, the method of Chaudhari et al. includes inorganic co-catalysts (column 1, lines 33-34), as in instant claims 29-33.

27. An artisan of ordinary skill in the art at the time of the instant invention would have been motivated to partake the concept emphasized by Agrafiotis et al. for an iterative process for generating chemical entities with define physical properties and/or bioactive properties (Abstract etc.) and improve on it by utilizing the method of Grate et al. which comprises using the properties chemical entities to identify a chemical sample. One of ordinary skill in the art at the

Art Unit: 1631

time of the instant invention would be further motivated to improve on the methods of Agrafiotis et al. and Grate et al. by including in the chemical space of Agrafiotis et al. and Grate et al. such chemical entities as catalysts (palladium and halide composition) and inorganic catalysts.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the method of Agrafiotis et al. for generating chemical entities and determining the properties as directed to the said chemical entities; and characterize the said chemical entities according to the method of Grate et al. using an algebra matrix and improve on the methods of Agrafiotis et al. and Grate et al. by including such chemical entities as catalysts (palladium and halide composition) and inorganic catalysts.

CONCLUSION

28. NO CLAIM IS ALLOWED.

29. Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (see 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (703) 308-3880. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

Art Unit: 1631

32. Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instruments Examiner, Tina Plunkett, whose telephone number is (703) 305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

C. Dune Ly
5/13/03


ARDIN H. MARSCHEL
PRIMARY EXAMINER